

REMARKS

Claims 14-15 and 17-18 stand allowed. Claims 1-13, 16 and 19-26 stand rejected under 35 USC §102(e) as being anticipated by Nielsen, U.S. patent 5,991,514.

Reconsideration and allowance of each of the presently rejected claims 1-13, 16 and 19-26 is respectfully requested.

Nielsen, U.S. patent 5,991,514 discloses a method and apparatus for printing a hyperspacial document with multiple pages. Each of the pages is composed in a markup language, and a respective printing element is included in each of the pages. The printing element for a given page is either an indicator of which of the pages is to print after the given page or an indicator that there is no page that prints next. When the header portion of a given page is transferred, it is checked to determine whether it contains a printing element. If the printing element is present, then a command to print the multiple pages is activated. The pages are printed in the order specified by the printing elements. On the server 240, the author of a set of hypertext pages for distribution over the web adds a META tag to the HEAD section of each page, indicating what web page is the next web page to print in the hypertext of this web page. In one embodiment, the META tag is as follows: <META NAME="PRINT-NEXT" CONTENT="http://www.server.com/directory/page.html" > In this tag, the value of the CONTENT attribute is a Uniform Resource Locator (URL) that specifies the next page that should be printed. If a page is the last page, the author eliminates the PRINT-NEXT META tag. For clarity, however, the author preferably uses the following META tag: <META NAME="PRINT-NEXT" CONTENT=""> Note that

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the CONTENT attribute can be any valid URL, including a pointer to information in another directory or on another server 240.

Reconsideration and allowance of the subject patent application including each of the claims 1-26, is requested. To anticipate under section 102, a prior art reference must disclose all the elements of the claimed invention or their equivalents functioning in essentially the same way. The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations in the claim are found in the reference, or 'fully met' by it."

Each of the independent claims 1, 22, and 25 distinguish over Nielsen, U.S. patent 5,991,514.

In Nielsen, each of the pages is composed in a markup language, and a respective printing element is included in each of the pages. The printing element for a given page is either an indicator of which of the pages is to print after the given page or an indicator that there is no page that prints next. When the header portion of a given page is transferred, it is checked to determine whether it contains a printing element. If the printing element is present, then a command to print the multiple pages is activated. The pages are printed in the order specified by the printing elements.

However, Nielsen fails to disclose and provides no suggestion of a stored

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document print index, as taught and claimed by Applicants.

Each of the independent claims 1, 22, and 25 recite that the print index is explicitly specified by a web based document originator and further recite the step of identifying uniform resource locators (URLs) in said print index or that the print index includes a list of user selected uniform resource locators (URLs) to be printed. This feature of the method, apparatus and computer program product for implementing web based document printing is not shown, nor suggest by Nielsen. Reconsideration and withdrawal of the rejection of the claims 1-13, 16 and 19-26 under 35 USC §102(e) as being anticipated by Nielsen is respectfully requested.

Each of the independent claims 1, 22, and 25 distinguish over Nielsen and are patentable.

Dependent claims 2-13, 16, 19-21, 23-24, and 26 further define the invention of patentable independent claims 1, 22, and 25, and are likewise patentable.

Applicants have reviewed all the art of record, and respectfully submit that the claimed invention is patentable over all the art of record, including the references not relied upon by the Examiner for the rejection of the pending claims.

It is believed that the present application is now in condition for allowance and allowance of each of the pending claims 1-26 is respectfully requested. Prompt and favorable reconsideration is respectfully requested.

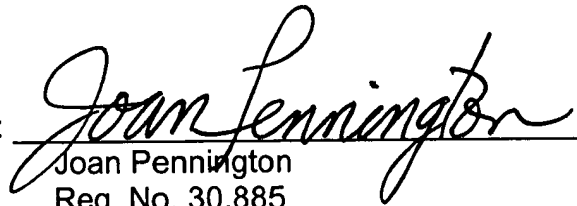
If the Examiner upon considering this amendment should find that a telephone interview would be helpful in expediting allowance of the present application, the Examiner is respectfully urged to call the applicants' attorney at the number listed

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below.

Respectfully submitted,

By:

A handwritten signature in cursive script, reading "Joan Pennington", written over a horizontal line.

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